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IN THE

Supreme Court of the United States

October Term, 1963
No. 861

ENGELHARD INDUSTRIES, INC.,
Petitioner,

vs.

RESEARCH INSTRUMENT CORPORATION,
Respondent.

Brief in Opposition to Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

Preliminary Statement.

Respondent believes that none of the factors justifying the exercise of this Court's certiorari jurisdiction are presented in the instant case and that in fact, the record clearly demonstrates against the exercise of that discretionary jurisdiction. When summary judgment was entered by the trial court after a full hearing, the determination that respondent's device did not infringe the claims of the patent in suit was supported by respondent's own evidence and admissions of petitioner which evidence was undisputed. Petioner's attempt, after the decision of the trial court granting summary judgment, to create an issue of fact from matters which it conceded were known prior to the motion but without submitting any showing of

excusable neglect whatsoever was rejected by the trial court in its discretion and the exercise of that discretion was affirmed by the court of appeals. Thus, this is a case in which two courts below have made factual determinations as to the appropriate exercise of the trial court's discretion, rulings which are clearly inappropriate for certiorari jurisdiction.

Moreover the clear language of the patent specification, the claims as finally allowed over the Haller patent on record and the statements made by the patentee's attorney to the Patent Office, fully supported that part of the District Court's decision that petitioner was estopped as a matter of law to contend that its claims covered respondent's device.

There is neither conflict in ruling or in principal between the judgment below and the decisions of this Court or of other courts upon which petitioner relies. Petitioner does not assert that there is any public interest in a second review of the determinations below and in fact, there is no such public interest. The question decided below is a narrow one and petitioner has made no showing to justify bringing it to this Court.

Questions Presented.

Respondent submits that the questions submitted by petitioner are not in fact presented by the record in the instant case. Substantially the only issue which the facts of this case presents for decision are the following:

Should this Court grant certiorari to review a decision of a Court of Appeals affirming the exercise of discretion by a Trial Court which, after a decision granting Summary Judgment on an undisputed rec-

ord, refused a motion for rehearing presenting additional affidavits which (a) contained matters which were known or should have been known by petitioner, although petitioner tendered no explanation whatsoever showing excusable neglect for failure to present the affidavits prior to the hearing and (b) which, even had they been considered, failed to create a "genuine issue of material fact".

Statement of the Case.

Research Instrument Corp. (Research), respondent herein, does not agree with petitioner, Engelhard Industries, Inc.'s (Engelhard) Statement of the Case as set forth in its Petition for Certiorari. The petitioner (Engelhard) filed a Complaint for Patent Infringement against respondent (Research) in the United States District Court for the Southern District of California based on jurisdiction on 28 U. S. C. 1338(a). Subsequently, the Complaint was amended to include a second cause of action for unfair competition under the provision of 28 U. S. C. 1338(b) [R. 2].

The controversy before the District Court concerned the use of a battery or galvanic cell for the purpose of determining the oxygen content of a gas. The battery or galvanic cell will produce a current by chemical reaction when oxygen is present in the battery or cell. The amount of current produced is read on an ammeter or other electrical measuring device and the amount of current so indicated represents the amount of oxygen.

Schematic drawings of batteries or galvanic cells including the Hersch device, prior art devices, and the appellee's device are found in Appendix A hereto. A similar sketch was before the District Court [R. 222].

and before the Court of Appeals for the Ninth Circuit (Appellee's Br. Appx. A).

The aforementioned sketches illustrate that in the operation of such devices, oxygen is brought into contact with one electrode of the battery, namely the cathode. The oxygen reacts with the liquid in the battery, known as an electrolyte, which causes the production of hydroxyl ions which in turn react with the anode, *i.e.* the other electrode in the battery, and produce a current which is measured on the ammeter or other current measuring device. In other words, the structure contains the same elements found in an ordinary car battery, two electrodes, *i.e.* a cathode and an anode, a solution of electrolyte, and when oxygen is fed into the battery, a current is produced that is read off on an ammeter.

The alleged novelty in the device patented and claimed in the Hersch patent in suit relates only to the cathode. The Hersch cathode is positioned partly below and partly above the liquid level of the electrolyte in the cell and constructed and operated in such a manner as to keep the area of the cathode positioned above said electrolyte level free of a film of electrolyte.

The essential feature of the method and the mode of operation of petitioner's invention as disclosed in its claims is that the area of the cathode extending above the liquid level of the electrolyte in the cell is free of electrolyte so that the oxygen contacting the cathode is not dissolved or diffused in electrolyte, but having contacted this area free of electrolyte the oxygen would travel down the cathode to the liquid level of the electrolyte and at that point, known as a three-phase boundary, results in the reaction which is measured.

In its answer to the Complaint, respondent pleaded, among other things, that its device did not infringe the claims of the patent in suit [R. 43, par. 7], and also pleaded the following affirmative defenses:

> "Defendant, RESEARCH INSTRUMENT CORP., avers that during the prosecution of the application that issued into the Letters Patent in suit, the patentee amended and cancelled claims of broader scope than the claims finally allowed in said patent as issued, whereby plaintiff is estopped to assert that the claims of the said patent are of a scope sufficiently broad to cover and include anything manufactured or sold by the defendant" [R. 46].

Respondent filed its Motion for Summary Judgment addressed both to the cause of action for patent infringement and for unfair competition [R. 90]. With respect to the patent infringement claims, respondent's Motion was based upon the contention:

1. That petitioner by reason of its representations to the Patent Office and under the doctrine of file wrapper estoppel was estopped from asserting that its patent covered the device manufactured by respondent.

2. That respondent's device did not infringe because its mode of operation was different than that covered by the claims of the patent in suit, in that respondent did not make use of the essential feature of the Hersch patent, the so-called "free area" on the cathode. Respondent contended that its device was such that the oxygen contacting the cathode was first diffused in electrolyte and that the reaction measured by respondent's device did not require that the oxygen, without diffusion, would travel down a bare cathode to the

liquid level of the electrolyte to be measured at the three-phase boundary point [R. 116-118].

In connection with respondent's contention as to the applicability of the doctrine of file wrapper estoppel, respondent filed with the Court a certified copy of the record before the Patent Office [R. Ex. A]. In connection with respondent's contention that the mode of operation of its device was different than and did not infringe the claims of the patent in suit, respondent lodged its device with the Court [Ex. A100] and respondent filed an affidavit of its expert, Lawlor, setting forth the mode of operation of this device [R. 197]. In addition, the Court, by respondent's reference, had before it four admissions by petitioner. Petitioner admitted by reason of these admissions, that it had one of respondent's devices and had operated it [Admissions 253 and 263, R. 82 and 86]. Petitioner also admitted by Admission 256 [R. 83] that in the operation of respondent's device, the oxygen contacting the cathode has diffused through the electrolyte to the cathode. In other words, petitioner admitted that respondent's unimmersed portion of the cathode is not free of contact with the electrolyte as set forth in each of the claims in suit.

The record discloses the following proceedings with respect to the respondent's Motion for Summary Judgment:

(a) Petitioner expressly recognized that the issues raised by respondent's motion for summary judgment included, specifically, respondent's contention as to the mode of operation of its device. Thus, petitioner filed four documents, each of which was addressed to this point [R. 150, 164, 180, 234].

(b) Petitioner made no request or application, which it was permitted to do under Rule 56(f), either before the hearing or at the hearing, that it desired the opportunity to present any additional matters to the Court other than its Supplemental Memorandum in Opposition to Defendant's Motion for Summary Judgment which, was filed after the hearing but before the Opinion was rendered [R. 231].

(c) Respondent lodged its device with the Court as an exhibit and filed the Lawlor affidavit [R. 197] which set forth the mode of operation of that device. Petitioner, prior to the Court's Memorandum Opinion, filed nothing in opposition to the Lawlor affidavit other than two affidavits which consisted entirely of conclusions. Petitioner tendered no factual statements with respect to the mode of operation of respondent's device, although it is admitted in this record that petitioner had possession of respondent's device and had analyzed it and examined it prior to respondent's Motion for Summary Judgment [Request for Admissions 253, R. 82]. Specifically, petitioner filed no affidavit of anyone which suggested any controversion of its admission in effect that respondent's unimmersed portion of the cathode was not free of contact with the electrolyte.

(d) The Trial Court granted respondent's Motion on July 24, 1961. It analyzed the record before it as respects the operation of respondent's device, and noted, that said record was undisputed and that there was no genuine issue as to the construction or operation of said device (Pet. Appx. B, p. 10). The Trial Court noted expressly that both the affidavits of Bryan and Hersch, filed in opposition to respondent's Motion on the issue of the method of construction and function

of respondent's device, "reaches no fact and creates no genuine issue" (Pet. Appx. B, p. 10). The Trial Court also noted the following:

> "This is particularly so as to the opinions of both Hersch and Cohn because the plaintiff has one of defendants' devices and has operated it (Admissions No. 253 and 263), and had plaintiff desired to, it could have pointed out by affidavit the precise construction and operation of defendants' device which may, or may not, have raised a genuine issue."
>
> "Moreover, by Admissions No. 256 and 257, plaintiff admits that defendants' device uses a wire screen cathode and that the oxygen contacting the cathode has diffused through the electrolyte to the cathode. The latter is another way of saying that defendants' unimmersed portion of the cathode is *not 'free'* of contact with the electrolyte, as set forth in each of the claims in suit" (Pet. Appx. B, p. 11).

(e) The Trial Court stated expressly that the Motion for Summary Judgment before it was "on the grounds that the pleadings, admissions, the patent in suit and its file wrapper will show file wrapper estoppel as to the infringement, that the patent, if valid, is uninfringed; that the patent is invalid; and that the plaintiff has no cause of action for unfair competition" (Pet. Appx. B, p. 8). In arriving at the conclusion that respondent's Motion should be granted, the Court stated that it had taken into consideration "only the pleadings; the patent in suit; its file wrapper; the defendant's device, auto-optically; plaintiff's admissions Nos. 253, 256, 257, 263; the affidavits of Lawlor, Bryan

and Cohn; and the numerous statements, arguments and briefs of counsel; all of the other ponderous matter submitted by the parties is irrelevant and immaterial on the issue of file wrapper estoppel" (Pet. Appx. B, p. 17).

(f) Seven weeks after the Trial Court's Opinion, petitioner filed a Motion for Rehearing and to its Motion attached certain affidavits as to the mode of operation and function of respondent's device [R. 252]. Both the Motion for Rehearing and the affidavits in support thereof were filed without any prior leave of Court. No reference appears in either petitioner's Motion or its Affidavits *denying* the fact that petitioner had and examined respondent's device prior to the Motion for Summary Judgment and no reference or explanation was offered as to why petitioner did not tender the affidavits prior to the Court's Memorandum Opinion. There was no attempted showing of any kind to indicate that the evidence was newly discovered or that there was some excusable neglect which explained the failure to submit the evidence prior to the Motion [R. 252].

(g) Moreover, the affidavits did not create any material issue of fact. Instead, they provided cumulative support that respondent's cathode is designed to cause the electrolyte to creep up the cathode, a construction which is exactly *opposite* to that contemplated by the device described and claimed in the patent in suit. The analysis of the belated affidavits is contained in respondent's brief in the Court of Appeals and will not be repeated here (Appellee's Br. p. 53).

Petitioner took its appeal to the Court of Appeals for the Ninth Circuit. In this connection, it filed

Notice of Appeal [R. 443], a Statement of Points on Appeal [R. 448], and a Brief before that Court. Nowhere in any of these documents did petitioner assert that the Trial Court was in error in denying petitioner's Motion for Rehearing. At no point in any of these proceedings did petitioner tender any justification for its failure to present the facts showing excusable neglect as respects the filing of the delayed affidavits.

Although, as noted above, petitioner made no assertion that the Trial Court was wrong in denying petitioner's Motion for Rehearing, the record designated by the parties before the Court of Appeals included every document conceivably relevant to the judgment of the Trial Court on both issues; *i.e.* the interpretation of the proceedings before the Patent Office and the noninfringing mode of operation of respondent's device [R. 444, 450]. Again, with respect to the second issue, petitioner expressly designated the portions of the record it deemed material thereto by designating its Motion for Rehearing and the belated affidavits of Cohn, Deller and Knapp filed in support thereof [R. 445].

Its brief before the Court of Appeals rested entirely on these affidavits. Petitioner followed this procedure without the slightest compunction that these affidavits had been filed *after* the decision by the Trial Court without leave and without any excuse or showing of excusable neglect. With this record before it, the Court

of Appeals affirmed the Judgment of the Trial Court, but only upon the grounds that respondent's device did not infringe the claims of the patent in suit. The Court held that respondent's device, by reason of its construction and mode of operation and method of function, did not infringe petitioner's patent because respondent's accused analyzer did not incorporate the distinctive feature of petitioner's invention, *i.e.* the "free area", as evidenced by petitioner's claims. This "free area", is critical to petitioner's patent because, as noted above, its invention otherwise would be anticipated by the prior art, particularly the invention of Haller [R. Deft. Ex. A, 47, 49, 54 and 55]. As noted above, petitioner emphasized and re-emphasized in its claims that by reason of this "free area" on its cathode, the oxygen impinges upon the dry cathode and travels down to the electrolyte where the reaction takes place which *petitioner's* analyzer measures.

With respect to the belated affidavits, the Court of Appeals held, as it was required to do by the undisputed record, that those affidavits were irrelevant. The Court noted:

> "They were tendered after that matter had been decided, with Engelhard's petition for rehearing, and were rejected. Since the petition was addressed to the discretion of the trial court [*Geo. P. Converse & Co. v. Polaroid Corp.*, 242 F. 2d 116 (1st Cir. 1957)], Engelhard was obliged to show not only that this evidence was newly discovered or unknown to it until after the hearing

but also that it could not with reasonable diligence have discovered and produced such evidence at the hearing. But Engelhard made no showing of any kind. Indeed from our examination of three of the four affidavits (the other was not made part of the record on appeal) it clearly appears that whatever facts they contain were readily available to and were known by Engelhard well in advance of the hearing." (Pet. Appx. B, pp. 27-28).

Finally, it should be noted that petitioner filed an application for rehearing with the Court of Appeals and even in that application failed to suggest any grounds showing that the evidence was newly discovered or unknown to it until after the hearing or showing that it could not, with reasonable diligence have discovered and produced such evidence at the hearing (Pet. Appx. B, p. 35).

ARGUMENT.

I.

This Court Should Not Grant Certiorari to Review Findings of Fact Made by Two Courts Below Demonstrating That the Trial Court Properly Exercised Its Discretion in Denying Petitioner's Motion for Rehearing.

A. Petitioner Made No Showing of Excusable Neglect to Support a Motion for Rehearing or to File Belated Affidavits.

It is conceded that the papers filed in opposition to respondent's motion for summary judgment in the Trial Court did not create "a genuine issue of material fact", as to the mode of operation of respondent's device. Thus, petitioner's brief admits that the counter-affidavits which it filed in opposition to respondent's motion, "were not conforming with the requirements of Rule 56(e) F.R.C.P. [R. 104]" (Pet. p. 5). The Trial Court and the Court of Appeals agreed. The Trial Court noted with respect to one of these affidavits that it was "hearsay, and at best, an expression of opinion" and with respect to the other affidavit, that it "reaches no fact and creates no genuine issue" (Pet. Appx. B. p. 10). This was not inadvertence because, as the Trial Court noted, admissions 253 and 263 [R. 82, 86] showed that plaintiff had one of respondent's devices and "had plaintiff desired to, it could have pointed out by affidavit the precise construction and operation of defendant's device which may, or may not, have raised

a genuine issue" (Pet. Appx. B. p. 11). The Court of Appeals agreed. It noted

> "Engelhard did file two opposing affidavits, but the court was obliged to disregard them for they contained only hearsay and legal conclusions. [*Gifford v. Travelers Protective Ass'n*, 153 F. 2d 209, 211 (9th Cir. 1946); See 6 Moore, Federal Practice 56.22, at page 2327-28 (1953)]; and there was nothing else in the record to counter the showing made by Research" (Pet. Appx. B. p. 27).

Neither in petitioner's points on appeal, specification of error or brief on appeal did petitioner make any contrary contention. It argued only, as noted by the Court of Appeals (Pet. Appx. B. p. 27) that the belated affidavits filed *after* the decision of the trial court thereby created an issue of fact.

But as the Court of Appeals held, the submission of these affidavits after the decision of the Trial Court as part of petitioner's motion for reconsideration required petitioner "to show not only that this evidence was newly discovered or unknown to it until after the hearing, but also that it could not with reasonable diligence have discovered and produced such evidence at the hearing. But Engelhard made no showing of any kind. Indeed from our examination of three of the four affidavits (the other was not made part of the record on appeal) it clearly appears that whatever facts they contain were readily available to and were known by Engelhard well in advance of the hearing" (Pet. Appx. B. pp. 27 and 28).

Finally, it should be noted that no showing of excusable neglect was made by petitioner in the trial court or in the court of appeals and that no contention was

made in the record on appeal before the court of appeals or in petitioner's brief that there had been an abuse of discretion by the trial court in denying the petition for rehearing. Thus, the record now before this court is that two lower courts have found, as a matter of fact, that the exercise of the trial court's discretion was well founded and amply justified. This court has long held that such circumstances do not call for the exercise of certiorari jurisdiction. Thus, in *Grazer Tank & Mfg Co. v. Linde Air Products Co.*, 336 U. S. 271, 275, 69 S. Ct. 535, this Court stated:

> "A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error."

B. The Decision Is Not in Conflict With Fountain vs. Filson, 69 S. Ct. 754, 336 U.S. 681, 93 L. Ed. 971.

The facts in the *Fountain* case quickly dispel any possibility of contention that the decision here is in conflict therewith. In the *Fountain* case, plaintiffs brought suit claiming a $6,000 interest in certain New Jersey realty. Their contention was that the defendants had acquired title to this realty subject to a resulting trust in favor of the plaintiffs in that amount. The defendants filed a Motion for Summary Judgment upon the sole grounds that New Jersey law would not permit the imposition of a resulting trust under the circumstances disclosed in the Complaint and in the other relevant documents. The Motion for Summary Judgment was granted to defendants upon that ground. On appeal, the Court of Appeals (171 F. 2d 999) held (a) that, as the Trial Court had held, no resulting trust

could arise out of New Jersey law; (b) that despite this fact, the plaintiffs' prayer for "other relief" would have permitted a personal judgment in lieu of a judgment for a resulting trust; (c) that a personal judgment for the *plaintiff* in the amount of $6,000 should have been entered and the Court of Appeals directed that it be entered.

Thus, the *Fountain* case is a case in which Summary Judgment for the defendant was entered by a Trial Court upon a particular ground and the Court of Appeals not only reversed that judgment but directed that Summary Judgment be entered in favor of the opposite party *upon a ground not presented for decision to the Trial Court.* In reversing, this Court stated:

> "The order was made on appeal on a new issue as to which the opposite party had no opportunity to present a defense before the Trial Court . . ."
> "There was no occasion in the Trial Court for Mrs. Fountain to dispute the facts material to a claim that a personal obligation existed, since the only claim considered by that Court on her Motion for Summary Judgment was the claim that there was a resulting trust (336 U. S. p. 683)."

In the instant case, as has been demonstrated in respondent's Statement of Facts, the issue upon which the Court of Appeals affirmed, *i.e.*, lack of infringement of respondent's device by reason of its different mode of operation, was *specifically presented to the Trial Court for decision.* It was part of respondent's Motion for Summary Judgment [R. 113] to which petitioner responded, although without any factual showing whatsoever [R. 192]. It was made expressly the basis

of the decision by the Trial Court (Pet. Appx. B, p. 10). It was argued on appeal by appellant (Appellant's Br. pp. 4-8 and 16-22). Since petitioner had the fullest opportunity under the rules to litigate the issue of non-infringement of the claims in suit by reason of the different mode of operation of respondent's device prior to the hearing on the Motion for Summary Judgment and that issue was expressly presented to the Trial Court for its decision and the Court of Appeals for its affirmance, the *Fountain* case is completely inapplicable.

Petitioner now complains that its designated record in the Court of Appeals on the issue of the mode of operation of respondent's device was inadequate "inadvertently" because it viewed the appeal as limited to the "issue of file wrapper estoppel" (Pet. Appx. B. p. 39). This contention is likewise without merit. As noted above, the mode of operation of respondent's device, as either infringing or not infringing the claims of the Hersch patent in suit, was always a critical issue in the Trial Court and on the appeal and petitioner expressly recognized it. It was one of the two specific issues in the Trial Court and in the Court of Appeals. If petitioner's designation of the record before the Court of Appeals was inadequate it was not because this issue was not raised or recognized but because petitioner understood at that time that there were no other portions of the record that were material. Its contention to the contrary now is the same kind of unexcused afterthrough as was its presentation of the belated affidavits in the Trial Court.

C. The Decision Below Is Not in Conflict With Other Cited Decisions of This Court or of the Courts of Appeal.

The decision below is not in conflict with *Sartor v. Arkansas Natural Gas Corp.*, 321 U. S. 620, 64 S. Ct. 724, 88 L. Ed. 967; *Poller v. Columbia Broadcasting System, Inc.*, 368 U. S. 466, 82 S. Ct. 486; or *Inglett and Company v. Everglades Fertilizer Co.* (C. C. A. 5, 1958), 255 F. 2d 342. Petitioner apparently asserts conflict with the *Sartor* and *Poller* cases, *supra*, upon the simplified proposition that in the *Sartor* and the *Poller* cases, summary judgments below were reversed by this court and therefore the instant decision ought to be reversed.

In the *Sartor* case, summary judgment deprived the plaintiff of a trial by jury. The controversy there arose with respect to a mineral lease for natural gas development which provided for the calculation of land owner royalty at the rate of market price, such market price under Louisiana law to be ascertained at the well head, if there was an established market price at that point, and if there was no price there, to be determined by considering numerous factors going to establish actual value at the well. *The same expert testimony which was the basis of summary judgment had theretofore been rejected by the jury.* This Court reversed, holding that the issue of market price was to be determined in a jury trial.

In the *Poller* case, *supra*, summary judgment for defendants had been entered by the trial court and affirmed by the Court of Appeals in an anti-trust case. The key issue was the existence of a contract, combination or conspiracy in restraint of trade in viola-

tion of 15 U. S. C. Sec. 1. There were extensive depositions in the record *from which conflicting inferences could be drawn.* This Court reversed.

In neither of these cases, was the critical fact supporting summary judgment established *without dispute from undenied affidavits and plaintiff's own admissions* as was true in the record of this case before the Trial Court at the time of its decision on the motion for summary judgment. Instead of the conflicting testimony on the issue of market price in *Sartor* and the conflicting testimony and inferences on the issue of conspiracy in *Poller*,[1] there was, in this case, the undisputed record that the mode of operation of respondent's device did not infringe the Hersch patent in suit. As has been noted above, this was established by the undisputed affidavit of Lawlor and the petitioner's admission to the effect that the unimmersed portion of the cathode in respondent's device is not free of contact with the electrolyte, as set forth in each of the claims in suit.[2]

Similarly, and upon the same grounds, the decision below is not in conflict with the *Inglett* case, *supra*. That case held only that upon the particular record *in*

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[1]Summary judgment in an anti-trust case was recently affirmed by this Court. *Silver v. New York Stock Exchange*, 373 U.S. 341, 83 S. Ct. 1246 (1963).

[2]Petitioner suggests that because in *Inglett, supra*, an affidavit of counsel was discounted, it is a matter of law that the affidavit of Lawlor in the instant case could not be considered. But the affidavit in the *Inglett* case was almost entirely devoted to summaries of a prior deposition and of matters not within the personal knowledge of the affiant. Here, Lawlor, a Physicist, testified on his own knowledge and that knowledge was completely substantiated by plaintiff's admissions. That affidavits on personal knowledge are admissible whether or not they are made by counsel is not disputable. (Rule 56(e), F.R.C.P.)

that case summary judgment by the Trial Court was unwarranted. The patent in the *Inglett* case, as described by the Court of Appeals, was for an improved method of weighing and bagging bulk materials by which weighed quantities sufficient to completely fill the Kraft bag are discharged from the hopper device through a large spout directly into the open mouth of the bag, held lightly in place by the operator, so that from the impact of the material, the bag drops quickly to a conveyor belt below, and is almost simultaneously carried away to allow the operator successively to repeat the process. The defendant contended that there was a prior use more than a year before the filing of the application which use was a substantial equivalent of the disclosure of the patent and upon this grounds filed the motion for summary judgment. As the Court noted, however, on the issue of the equivalence of the device alleged to have been in prior use, the affidavits of the moving party were *countered by affidavits of the plaintiff*. On the critical issue of the date of such prior use; the Court expressly noted that a factual conclusion on this point could be reached only by weighing the conflicting evidence disclosed in the deposition. The court expressly noted that because of the very nature of the deposition testimony itself, a conclusion as to the date of prior use "would be the product of weighing assimilating, sifting and inferring". 255 F. 2d 342, 346. The Court concluded that the deposition "presented genuine factual controversy."

But as noted above, the record before the Trial Court in this case, on the critical issue was undisputed. As the Trial Court stated.

"In arriving at the foregoing conclusion, the court has taken into consideration only the plead-

ings; the patent in suit; its file wrapper, the defendant's device, auto-optically; plaintiffs' admissions Nos. 253, 256, 257 and 263; the affidavits of Lawlor, Bryan and Cohn; and the numerous statements arguments and briefs of counsel" (Pet. Appx. B, p. 17).

From this record, noninfringement was established without dispute and there was no other portion of the record which created a conflict on that issue whatsoever.

Petitioner suggests that certain *denials* by it of other requests for admissions upon which the Trial Court did not rely, constitutes evidence which created a question of fact precluding summary judgment (Pet. p. 10). The objections to this contention are insurmountable for the following reasons:

(1) Not a single document filed by petitioner in response to respondent's Motion for Summary Judgment made any contention that these denials constituted affirmative evidence creating a "genuine issue" as to any material fact.

(2) These denials were not designated as part of the record on appeal [R. 444 and 450], or in this court.

(3) Petitioner did not specify these denials of requests for admission as error and did not present them in its brief before the Court of Appeals [R. 448; Pet. Br. p. 3].

Thus, these denials could form no basis of the decision by the Court of Appeals below (*Watson v. Button* (C. A. 9, 1956); 235 F. 2d 235), and may not be the basis for a Petition for Certiorari here.

Petitioner made no contention that these denials created an issue of fact because such a contention is patently unsound. A denial of a requested admission of fact does not constitute affirmative evidence to create a disputed issue of fact within the meaning of Rule 56 of the Federal Rules of Civil Procedure. *Dulansky v. Iowa-Illinois Gas and Electric Co.* (U.S.D.C.S.D. Iowa, 1950), 10 F.R.D. 566, reversed on other ground *Dulansky v. Iowa-Illinois Gas and Electric Co.* (C. A. 8, 1951), 191 F. 2d 881).

As noted in the *Dulansky* opinion with reference to denials of requests for admissions, 10 F. R. D. 576-578,

> "if a party denies a request, he cannot thereafter resist a motion for summary judgment, with which is submitted an affidavit supporting the facts contained in the request, unless the party who denied the request produces some substantial and genuine evidence supporting his denial which would create an issue of material fact."

As Professor Moore notes:

> "The summary judgment procedure prescribed in Rule 56 is a procedural device for promptly disposing of actions in which there is no genuine issue as to any material fact. In many cases there is no genuine issue of fact, although such issue is raised by the formal pleadings. * * * 'The very object of a motion for summary judgment is to separate what is formal or pretended in denial or averment from what is genuine and substantial, so that only the latter may subject a suitor to the burden of a trial.' To attain this end, the rule permits a party to pierce the allegations of fact in

the pleadings and to obtain relief by a summary judgment where facts set forth in detail in affidavits, depositions, and admissions on file show that there is no genuine issue of fact to be tried" (6 Moore Federal Practice 2028, 2029).

D. Respondent Had a Substantial Right to Summary Judgment on the Record Before the Trial Court and Rule 61 of the Federal Rules of Civil Procedure Is Therefore Inapplicable.

Petitioner suggests that the application of Rule 61 of the Federal Rules of Civil Procedure which requires the court to disregard error which "does not effect the substantial rights of the parties" justifies certiorari. This suggestion by petitioner can only be regarded as facetious. Rule 56(c) expressly provides that if there is "no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law" that the judgments sought "shall be rendered forthwith".

The mandatory right of respondent to judgment in its favor is an important and substantial right and the complete absence of any facts in opposition to its motion is not such an error or defect which could be disregarded. If it were true that parties could gamble upon the court's decision by withholding evidence and then urge Rule 61 automatically as an excuse to justify presenting such evidence until after an adverse decision, then the value of Rule 56 as an important procedural rule is destroyed. Of course, it is no new experience for a district court to find a losing party dissatisfied with a ruling granting summary judgment and for that party to thereafter submit additional documents. It is well established that under such circumstances the district

court may properly disregard such documents particularly where no showing has been made as to why they were not filed earlier. *George P. Converse & Co. v. Polaroid Corporation* (C. A. 1, 1957), 242 F. 2d 116, 121; *Clark v. Montgomery Ward & Company* (C. A. 4, 1962), 298 F. 2d 346, 349; *Atlas v. Eastern Air Lines, Incorporated* (C. A. 1, 1962), 311 F. 2d 156, 162.

II.

The Judgment by the District Court Herein That Petitioner by Reason of the Language of the Patent Specification, the Claims as Finally Allowed Over the Haller Patent on Record and the Statements Made by the Patentee to the Patent Office Estopped Petitioner to Contend the Claims of the Patent in Suit Covered Respondent's Device Was Clearly Correct as a Matter of Law and This Court May Sustain the Judgment Upon That Ground.

The principle of the doctrine of "file wrapper estoppel" has been firmly established in this Court: "Thus, in the early case of *Shepard v. Carrigan*, 116 U. S. 593, 597, 6 S. Ct. 493, 29 L. Ed. 723, the Supreme Court had before it the question as to whether a patentee who had limited his claim after rejection by the Patent Office could expend it again after the issuance of the patent to cover the accused device. In rejecting the patentee's assertion, the court said:

> "Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the patent-office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by

dropping the element which he was compelled to include in order to secure his patent. Leggett v. Avery, 101 U.S. 256; Goodyear Dental Vulcanite Co. v. Davis, 102 U.S. 222-228; Fay v. Cordesman, 109 U.S. 408; S.C. 3 Sup. Ct. Rep. 237; Mahn v. Harwood, 112 U.S. 354-359; S.C. 5 Sup. Ct. Rep. 174; Cartridge Co. v. Cartridge Co., 112 U.S. 624-644; S.C. 5 Sup. Ct. Rep. 475; Sargent v. Hall Safe & Lock Co., 114 U.S. 63; S.C. 5 Sup. Ct. Rep. 1021."

To the same effect; see *Smith v. Magic City Kennel Club*, 282 U.S. 784, 789, 51 S. Ct. 291.

The application of those cases to the instant case is clearly shown by the record because by reason of the express disclaimers, admissions and limitations found in the prosecution of the patent in suit, it is clear that petitioner is estopped as a matter of law from contending that the claims of the Hersch patent covered a device having a cathode designed to cause the electrolyte to creep up the exposed portion of the said cathode and form a film of electrolyte thereon. The record references establishes the foregoing as a matter of law including the foregoing:

1. Patentee's representation in the specifications that the electrolyte must be stagnant and the cathode constructed of a material that would prevent any creeping up of electrolyte up that portion of the cathode extending above the liquid level of the electroylte in the device [Hersch Patent in suit, column 3, lines 15-42; R. Deft. Ex. A].

2. The claims as originally presented were not limited to a cathode having its exposed portion free of

electrolyte or means to prevent a film of electrolyte from forming on the cathode including a special cathode design and a stagnant electrolyte [R. Ex. A, pp. 23-31].

3. The patentee's attorney urged that it was a substantial feature of the patentee's invention that the electrolyte be stagnant and that the cathode be so designed as to prevent any film of electrolyte from creeping up that portion of the cathode extending above the liquid level of the electrolyte in the device [R. Ex. A, pp. 47, 49, 54, 55, 59, 79, 96, 97, 98, 99, 100].

4. The patentee testified in this case under oath as follows: "I do not contemplate taking any deliberate steps to produce a film of electrolyte on the exposed part of the cathode and I do not consider such a film as beneficial" [R. Tr. of Hersch Dep. p. 219].

After all of the patentee's initial claims were rejected over the Haller patent, the patentee formally accepted limitations for redrafting the claims to include language requiring that the exposed portion of the cathode be free of electrolyte and that the electrolye be kept stagnant to insure this result [R. Hersch Patent Claims 1, 7, 10, 11, 12, 14, 17; R. Deft. Ex. A].

These limitations in the claims were accepted by the patentee in order to overcome the Haller reference because in that reference there is an exposed portion of the cathode with a film of electrolyte thereon and a means to cause a film of electrolyte to be so positioned [Deft. Ex. A, p. 100].

Thus, the limitations necessarily urged by the patentee to distinguish over the Haller patent was that the exposed portion of the Haller cathode had a film of electrolyte thereon and in the patentee's device there was

no film of electrolyte on the portion of the cathode extending above the liquid level of the electrolyte in the device [R. Deft. Ex. A, pp. 47, 54, 55].

It is clear, therefore, in view of the law of file wrapper estoppel as established by this Court that petitioner cannot now urge a construction for the claims of his patent that would cause them to read on a cathode having an electrolyte film on any portion thereof extending above the water line or the liquid level of the electrolyte in the device. There is no dispute in this action that respondent's device falls within the area thus disclaimed by the patentee thus the doctrine of file wrapper estoppel clearly applies.[3]

III.

The Issues in the Instant Case Are Factual and Relate to These Parties Only and Have No Public Interest. Certiorari Therefore Is Not Justified.

The nature of the question in this case in the light of the record, does not support the granting of certiorari. It is apparent from the record here, that the questions presented are important only to the parties to this action and to no one else. The record discloses that the factual issue is the justifiable exercise of discretion by the trial court in denying petitioner's belated attempt to create an issue of fact without even an attempt to show excusable neglect. Thus, the decisions below turn upon their own facts and can not effect any other litigants. Moreover, as we have noted, the judgment below is clearly correct.

[3]The Court of Appeals erroneously, it is submitted, failed to apply this court's decisions on this issue. Of course, certiorari may be denied upon any justifiable ground whether or not it was sustained in the Court below.

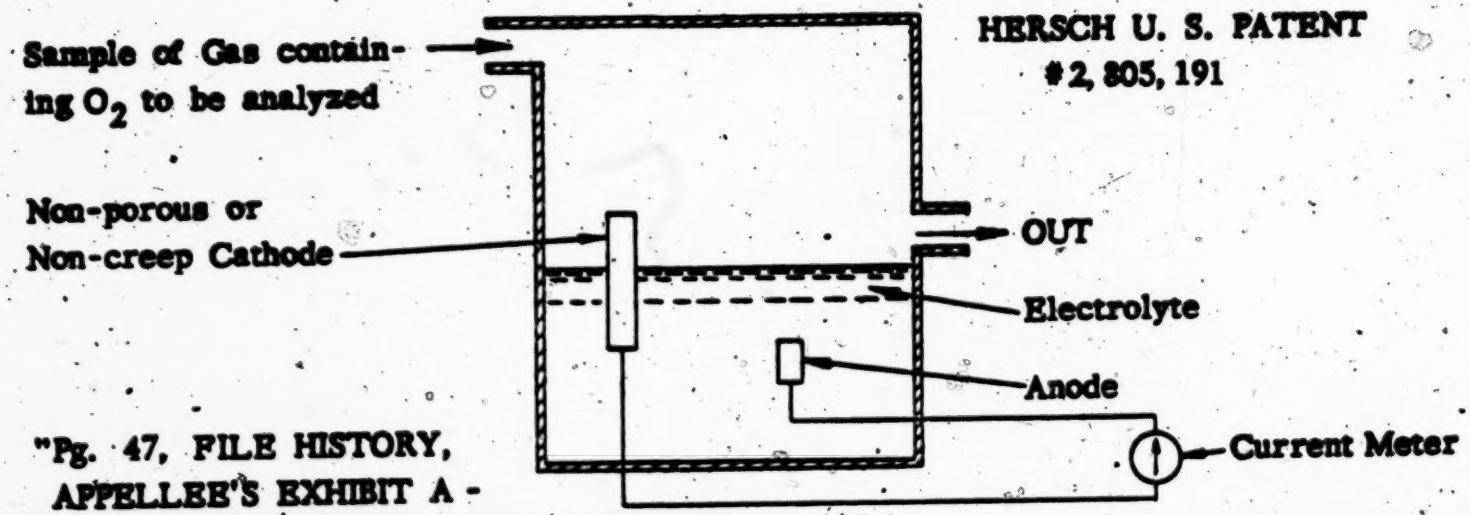
Walling v. General Industries Co., 330 U.S. 545, 67 S. Ct. 883 (1947).

Conclusion.

It clearly appears from the record before this court that petitioners have made no showing sufficient to warrant the exercise of this court's certiorari jurisdiction. The Petition for Writ of Certiorari should be denied.

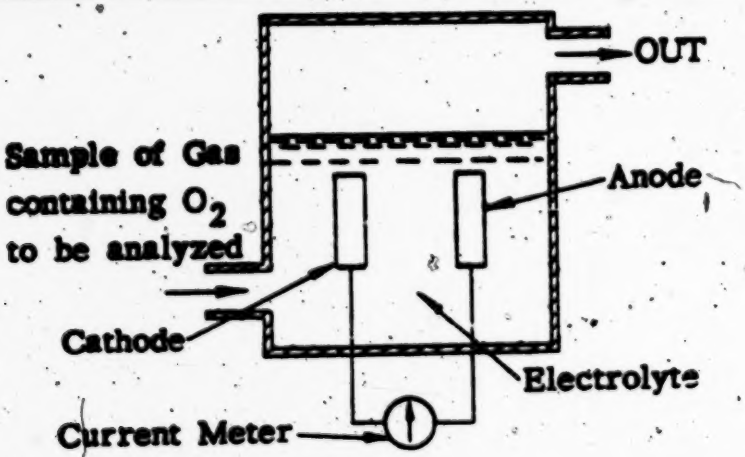
Respectfully submitted,

KENDRICK & STOLZY,
ELWOOD S. KENDRICK,
By ELWOOD S. KENDRICK,
Attorneys for Respondent.



HERSCH U. S. PATENT #2, 805, 191

"Pg. 47, FILE HISTORY, APPELLEE'S EXHIBIT A - HERSCH DEPOSITION, Pg. 171, lines 8-13"



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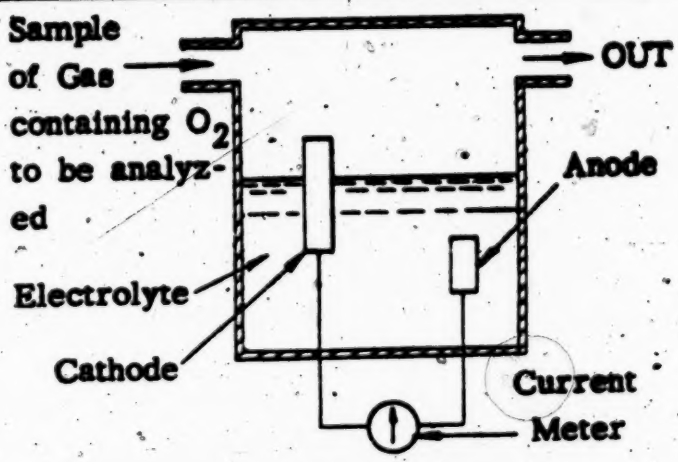
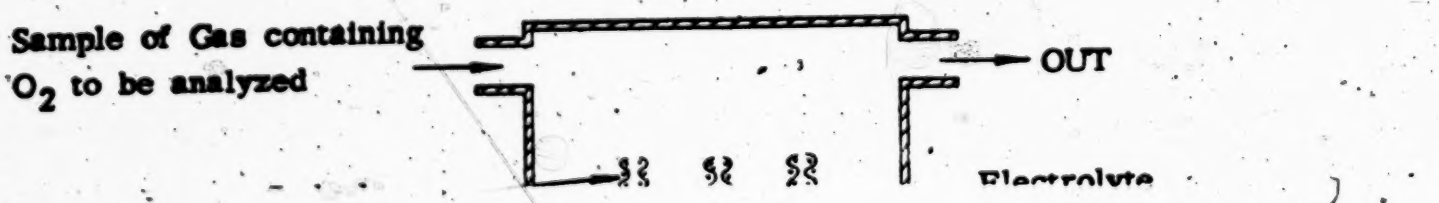
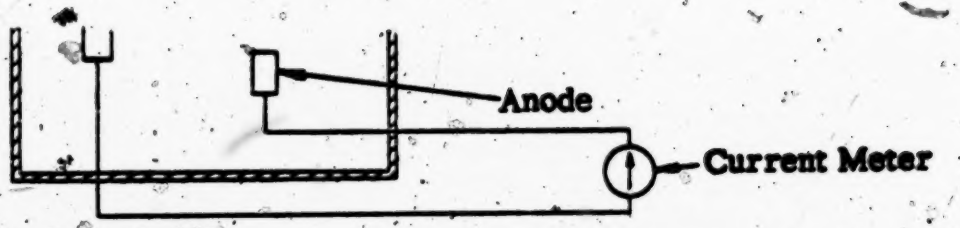
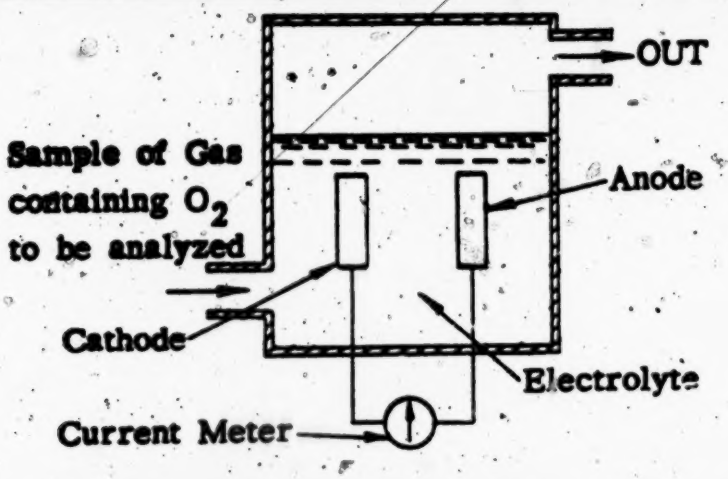


"GERMAN PATENT # 749, 603 - APPELLEE'S EXHIBIT A-102 HERSCH DEPOSITION - Pg. 93, line 24 through Pg. 94, line 26. JACOBSON PATENT - APPELLEE'S EXHIBIT A-103."





"Pg. 47, FILE HISTORY, APPELLEE'S EXHIBIT A - HERSCH DEPOSITION, Pg. 171, lines 8-13"



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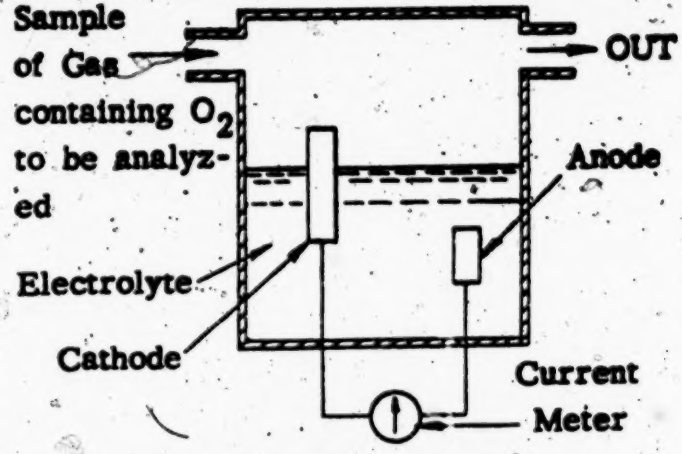
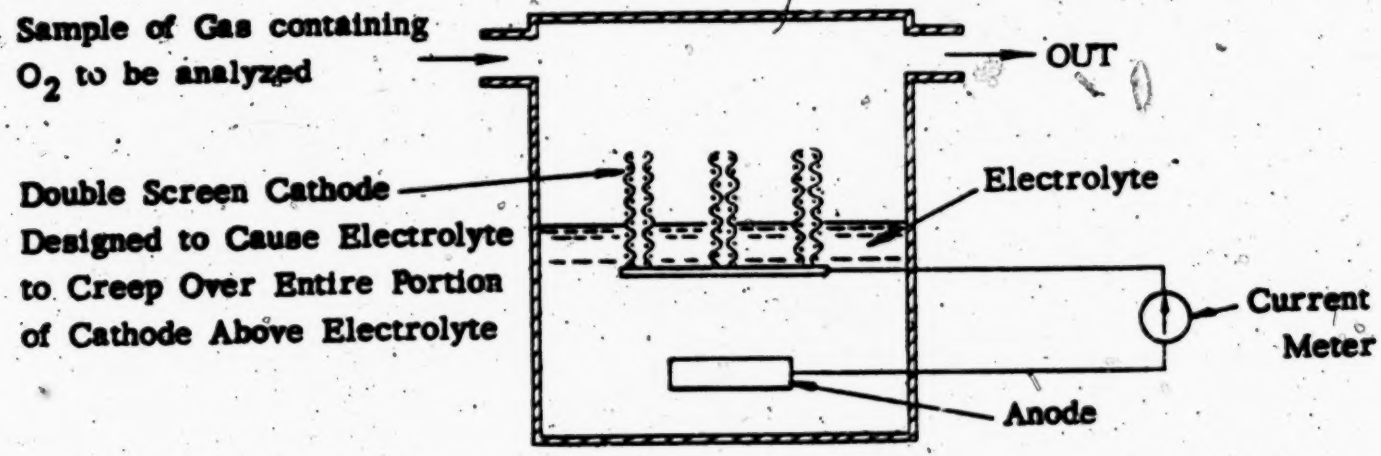


"GERMAN PATENT # 749, 603 - APPELLEE'S EXHIBIT A-102 HERSCH DEPOSITION - Pg. 93, line 24 through Pg. 94, line 26. JACOBSON PATENT - APPELLEE'S EXHIBIT A-103."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Electrolyte
Current Meter
Anode

"APPELLEE'S EXHIBIT A100 - LAWLOR AFFIDAVIT [R. 199, lines 6-23]"